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**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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CH

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/392,270 09/09/99 POIRIER

J 1-21036

027210 QM32/0410
MACMILLAN, SOBANSKI & TODD, LLC
ONE MARITIME PLAZA - FOURTH FLOOR
720 WATER STREET
TOLEDO OH 43604

EXAMINER

NGUYEN, T
ART UNIT

PAPER NUMBER

3726
DATE MAILED:

04/10/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/392,270

Applicant(s)
Poirier et al.

Examiner
Trinh Nguyen

Group Art Unit
3726



☒ Responsive to communication(s) filed on Jan 22, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-16 is/are pending in the application.

Of the above, claim(s) 8-14 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7, 15, 16 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Double Patenting

1. Claims 1-7, 15, and 16 are directed to an invention not patentably distinct from claims 11-20 of commonly assigned 09/408,747. Specifically, the subject matters in the instant application are claimed as method claims as similar to the claims of the cited application and the differences, i.e., deleting and/or adding subject matters, therebetween would have been obvious.
2. Commonly assigned 09/408,747, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78[©] and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321[©] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-7, 15, and 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-20 of copending Application No. 09/408,747. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matters in the instant application are claimed as method claims as similar to the claims of the cited application and the differences, i.e., deleting and/or adding subject matters, therebetween would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. **Claims 1-7, 15, and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Applicant's Admitted Prior Art** (as set forth in lines 13-29 of page 1, all of pages 2 & 3, lines 1-10 of page 4, lines 19-24 of page 6, lines 1-22 of page 7, lines 16-26 of page 8, and lines 22-25 of page 9; hereinafter is referred to as **AAPA**).

AAPA discloses that it is old and well known to manufacture a vehicle frame structure by: providing a closed channel workpiece member; performing a heat treatment process to softening the workpiece member; and deforming the workpiece member to form a vehicle frame structure. Further note that the use of inductive heating coil and quenching ring are well known and conventional as admitted by the Applicants in lines 18 & 19 of page 8 and line 23 of page 9. **AAPA** teaches the claimed invention except to mention that when performing the heat treatment process on the workpiece the inductive heating coil and the quenching ring are moved in a continuous and longitudinal manner from one end of the workpiece to the other end. However, an **Official Notice** is taken that the concept of heat treating a workpiece with a device, in this case an inductive heating coil and a quenching ring, either in a stationary manner or in a continuous manner relative to the workpiece is notoriously old and well known throughout the art, in order to easily and economically deform a workpiece member due to its low and/or high threshold temperatures.

Regarding claims 4-7, **AAPA** sets forth the invention as cited above with the exception of the orientation of the workpiece. It would have been obvious to one of ordinary skill in the art at the time the invention was made that whether the heat treatment process is performed by

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suspending and/or supporting the workpiece member vertically or horizontally by an upper end and/or lower end is a matter of design choice since no significant problem is solved or unexpected result obtained by supporting the members in the orientation claimed versus that taught by the prior art.

It is noted that the Applicants recite specific article design limitations in claims 15 and 16, i.e., specific material limitations, however, such limitations must result in a manipulative difference in the recited process steps as compared to the prior art. In this instance these design limitations are held to be obvious and not given patentable weight in these method of manufacturing claims as such limitation(s) do not result in any difference in the *claimed* manufacturing process.

Response to Arguments

7. Applicant's arguments with respect to claims 1-7, 15, and 16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Trinh Nguyen** whose telephone number is **(703) 306-9082**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

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TTN

April 4, 2001

J. C. A. R. h
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